



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,578	07/26/2000	TADASHI KURIYAMA	106336	9483

25944 7590 04/01/2003

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 04/01/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/555,578

Applicant(s)

KURIYAMA ET AL.

Examiner

Brian P. Egan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-9 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1;2,6-9 and 12 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 9 is objected to because the claimed limitations are directed at functional recitations, i.e., “wherein said tack label is peeled from the container body within 30 minutes when the container body is immersed in 75°C hot water, while said tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40°C water.” The functional recitation has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a “means” for performing the specified function, as set forth in 35 U.S.C. 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The rejection of Claim 9 under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention is maintained from the previous office action. The phrase, “said tack label is not easily peeled” is indefinite. It is unclear to what degree of peeling constitutes something being “easily peeled.” The Applicant contends that pages 3-4 of the specification sufficiently describe the aforementioned “easily peeled” phraseology by defining “easily peeled” to mean a label with

Art Unit: 1772

“low peeling resistance.” Although “peeling resistance” is depicted in Figs. 5(a-c), the figures only define peeling resistance values on a scale of 0-120 of a “relative value.” It is therefore still unascertainable exactly what “easily peeled” means since there is no value but a “relative value” to gauge it by. How much decrease in peeling strength is actually occurring between 0 and 100 of a “relative value”? Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 6-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowman (GB 2,259,291 A) in view of Romagnoli (#4,060,168).

Lowman teaches a plastic container (Fig. 1, #10) with a tack label comprising a label base material (p.4, lines 7-9), a printing layer formed on a first surface of the base material (p.2, lines 10-12), and an adhesive layer formed on a second surface which opposes the first surface of the label base material (p.1, line 24 to p.2, line 2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract; p.2, lines 20-26; p.3, lines 12-15). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract). The adhesive layer comprises an acrylic water-soluble adhesive (p.2, lines 23-26) and the base label

Art Unit: 1772

material comprises a material (paper) whose specific gravity is less than one (p.2, lines 17-19; see Also *On the Distribution of Mass, Thickness, and Density in Paper*, Fig. 2, page 4, for verification of the density of paper ($0.4-0.85 \text{ g/cm}^3$)). Although Lowman does not explicitly state that the tack label is peeled from a container body within 30 minutes when the container body is submersed in 75 degrees Celsius hot water and that the tack label is not easily peeled from the container body in a lapse of 30 minutes after the container body is immersed in 40 degrees Celsius water, the aforementioned limitation is inherently met since Lowman discloses the same adhesive material composition as the claimed invention, therefore rendering the material properties inherently consistent.

Lowman fails to teach the use of a masking layer that is situated in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer wherein a masking layer may also be placed on a portion of the edge of the adhesive layer.

Romagnoli, however, teach a label construction that is applied to bottles wherein a masking layer ("cut portion") is formed in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer and where a second masking layer (and optionally third (i.e., the tab portion)) is formed in the edge portion of the adhesive layer (see Fig. 7, #s 22, 23, and 34; Col. 3; lines 20-31). Romagnoli does not explicitly state that the masking layer portions comprise between 5 and 90% of the adhesive surface area, although Romagnoli does teach that the masking portions may be any desired shape (Col. 3, lines 3-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layers based on the desired shape of the end product. Furthermore, it would have been obvious to one

Art Unit: 1772

of ordinary skill in the art at the time Applicant's invention was made to have modified the percent surface area coverage of the masking layer by changing the shape of the masking components, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Also note that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Romagnoli teaches the use of the masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle (Col. 1, lines 42-50; Col. 3, lines 26-31 and 40-45). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified an adhesive label for a bottle by using masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle as taught by Romagnoli.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicants invention was made to have modified Lowman to include masking layer portions in the central area of the adhesive and along the peripheral edge of the adhesive as taught by Romagnoli in order to provide portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking

Art Unit: 1772

layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle.

6. Claims 1-2, 6-9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowman (GB 2,259,291 A) in view of Jones (#4,550,683).

Lowman teaches a plastic container with a tack label as detailed above. Lowman fails to teach the use of a masking layer that is situated in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer wherein a masking layer may also be placed on a portion of the edge of the adhesive layer.

Jones, however, teaches a label with a masking layer divided into multiple portions such that the label comprises a masking layer portion in the central region of the adhesive layer with a ring of adhesive about the central masking layer portion as well as a masking layer portion along the peripheral edge of the adhesive (see Figs. 1-3). Each section masking layer portion is removable from the adhesive (see Fig. 1), thereby allowing for between 0 and 100% of adhesive surface area coverage by the masking layer portions. Jones teaches the use of the masked adhesive label for the purpose of providing a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have provided an adhesive label with multiple masking layer portions for the purpose of providing a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate as taught by Jones.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Lowman to include multiple removable masking portions as taught by Jones in order to provide a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate.

7. Claims 1-2, 6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (#4,444,839) in view of Romagnoli (#4,060,168).

Dudzik et al. teach a plastic container (Col. 1, lines 19-22) with a tack label comprising a label base material (Fig. 1, #1), a printing layer formed on a first surface of the base material (Fig. 1, #4), and an acrylic adhesive layer (Col. 2, lines 9-18) formed on a second surface which opposes the first surface of the label base material (Fig. 1, #2), wherein the adhesive layer comprises a hot water-soluble adhesive which is difficult to dissolve in water at normal temperature and easy to dissolve in hot water (see Abstract). The tack label is easy to peel from the container under an environment with hot water while difficult to peel from a container body under an environment with normal temperature water (see Abstract; Col. 1, lines 36-39). Dudzik et al. further teach that the label is not detached from the container by the action of condensation water, sprayed water, or rainwater or aqueous liquids below a temperature of 30°C, but can be detached and dissolved, without problems (i.e., easily peeled), using water which has a temperature of about 50°C (Col. 3, lines 3-10). Dudzik et al. further teach the removal step occurs at 70°C (Col. 3, lines 44-52). Dudzik et al. ultimately define hot water as water at temperatures above 50°C and cold water as water at temperatures below 30°C (Col. 5, lines 12-14; Col. 1, lines 52-55).

Although Dudzik et al. teach the use of a masking layer (Fig. 1, #3), Dudzik et al. fail to teach the masking layer being cut such that a portion of the masking layer remains on the central or outside portions of the adhesive layer when applying the label to the bottle.

Romagnoli, however, teach a label construction that is applied to bottles wherein a masking layer (“cut portion”) is formed in the central region of the adhesive layer thereby forming a ring of adhesive about the masking layer and where a second masking layer (and optionally third (i.e., the tab portion)) is formed in the edge portion of the adhesive layer (see Fig. 7, #s 22, 23, and 34; Col. 3, lines 20-31). Romagnoli does not explicitly state that the masking layer portions comprise between 5 and 90% of the adhesive surface area, although Romagnoli does teach that the masking portions may be any desired shape (Col. 3, lines 3-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant’s invention was made to have modified the percent surface area coverage of the masking layers based on the desired shape of the end product. Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant’s invention was made to have modified the percent surface area coverage of the masking layer by changing the shape of the masking components, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Also note that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Romagnoli teaches the use of the masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer

Art Unit: 1772

portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle (Col. 1, lines 42-50; Col. 3, lines 26-31 and 40-45). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified an adhesive label for a bottle by using masking layer portions for the purpose of providing portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle as taught by Romagnoli.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicants invention was made to have modified Dudzik et al. to include cut masking layer portions in the central area of the adhesive and along the peripheral edge of the adhesive as taught by Romagnoli in order to provide portions that may be used as promotional items or as a surface to print directions on that can be viewed through a transparent bottle while also providing masking layer portions along the peripheral edge of the adhesive layer to facilitate removal of the label from the bottle.

8. Claims 1-2, 6, and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (#4,444,839) in view of Jones (#4,550,683).

Dudzik et al. teach a plastic container with a tack label as detailed above. Although Dudzik et al. teach the use of a masking layer (Fig. 1, #3), Dudzik et al. fail to teach the masking layer being cut such that a portion of the masking layer remains on the central or outside portions of the adhesive layer when applying the label to the bottle.

Jones, however, teaches a label with a masking layer divided into multiple portions such that the label comprises a masking layer portion in the central region of the adhesive layer with a ring of adhesive about the central masking layer portion as well as a masking layer portion along the peripheral edge of the adhesive (see Figs. 1-3). Each section masking layer portion is removable from the adhesive (see Fig. 1), thereby allowing for between 0 and 100% of adhesive surface area coverage by the masking layer portions. Jones teaches the use of the masked adhesive label for the purpose of providing a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate (see Abstract). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have provided an adhesive label with multiple masking layer portions for the purpose of providing a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate as taught by Jones.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Dudzik et al. to include multiple removable masking portions as taught by Jones in order to provide a label that is applicable to a work surface that provides both masking properties while also providing a user the ability to apply a predetermined design configuration to the desired substrate.

9. Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dudzik et al. (#4,444,839) in view of either Romagnoli (#4,060,168) or Jones (#4,550,683), and further in view of Freedman et al. (#6,165,576).

Art Unit: 1772

Dudzik et al., Romagnoli, and Jones teach a tack label as detailed above. The aforementioned prior art fails to teach a label base material with a specific gravity of less than one.

Freedman et al., however, teach a peelable label that is used in combination with a recyclable bottle (see Abstract). Freedman et al. teach that the label base material has a material with a specific gravity of below 1 for the purpose of providing a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation (Col. 8, lines 30-40). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have selected label materials based on the specific gravity value of that material for the purpose of providing a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation as taught by Freedman et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the aforementioned prior art to include a label base material with a specific gravity of less than one as taught by Freedman et al. in order to provide a label base material with a label base material sufficiently different than the specific gravity of the bottle material such that the two materials can be successfully separated from one another in a recycling operation.

Art Unit: 1772

Response to Remarks

10. Applicant's arguments with respect to claims 1-2, 6-9, and 12 have been considered but are moot in view of the new ground(s) of rejection.

Note that the 35 U.S.C. 112, second paragraph, rejection of claims 1 and 8 has been withdrawn by the Examiner for the use of the terms "hot water" and "normal temperature" pursuant to the Applicant's remarks. The Examiner, in accordance with the specification, has defined "hot water" to encompass temperatures at "about 75°C" and "normal temperature" to encompass temperatures at "about 22°C."

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
March 11, 2003




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 3/24/03